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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,562	03/18/2002	Masatsugu Koguchi	325772028200	3154
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 5500 2000 Pennsylvania Avenue, N.W. Washington, DC 20006-1888		EXAMINER PATIL, ASHOKKUMAR B		
		ART UNIT 2154		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/098,562

Applicant(s)

KOGUCHI, MASATSUGU

Examiner

ASHOK B. PATEL

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-13 are subject to examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Mali (US 7, 103, 633 B1).

Referring to claim 1,

Mali teaches a data transmission apparatus for transmitting image data over a network (Abstract and col. 2, line 32-36, "For example, if the receiving facsimile machine is capable of receiving facsimiles in a "fine" or "detail" mode, or can use a half-tone method of communication, these higher quality images are utilized and transmitted, when desired."), the data transmission apparatus comprising:

an image reader for obtaining image data by reading an original document (col. 6, line 39-41, "A scanner 138 is utilized to scan images of documents which are to be transmitted by facsimile.");

a storage device in which the obtained image data is stored (col. 6, line 3-17, "A storage interface 110 is connected to a non-volatile memory 112, a hard disk 114, and a CD which may be a CD ROM drive, a write once/read many drive, a read/write drive which allows re-writing of data on the same disk, a magneto optical disk, or any other type of disk. The non-volatile memory may be limited as a RAM having a battery back-up, a flash memory, EPROM, EEPROM, CMOS battery, hard disk, or any other non-volatile memory device. The non-volatile memory 112 may be utilized to store autodial or speed dial telephone numbers. Additionally, or alternatively, the non-volatile memory 112 is utilized to store profile or capabilities data. This data may be from facsimile machines with which the device of FIG. 3 communicates, or may be utilized to store the options and capabilities of the device illustrated in FIG. 3.");

a requester to transmit a request to a recipient device to which the image data stored in the storage device is to be sent, for a designation of conversion processes to be performed to the image data (Fig. 8, col. 12, line 58- col. 13, line 2, "FIG. 8 illustrates a data structure 340 which includes the profile information of a fax machine which sets forth the capabilities of the fax machine. The data structure 340 includes a field 342 which indicates whether the fax machine can transmit in standard, detail, and/or fine mode. Field 344 indicates whether the fax machine has half tone capabilities, and field 346 indicates the various paper sizes which can be utilized by the fax machine. Field

348 illustrates the maximum transmission speed of the fax machine and can be, for example, 2.4 K, 4.8 K, 9.6 K, 14.0 K, 19.2 K, 32.0 K, 48.0 K, 56.0 K, 64.0 K, 128.0 K, or another transmission speed. Any other speed information may be stored, if desired.");

a first receiver to receive from the recipient device the designation of the conversion processes (Fig. 3, element 102, COMM, I/F "network", Fig. 7c, col. 5, line 56-60, "There is a communication interface 102 which may be utilized to connect to a computer network or a PSTN. The communication interface 102 may be implemented to have the structure and function of a fax interface and/or a LAN or other network interface.", col.6, line 26-3, "Connected to the system bus is a LAN interface 126 which may be utilized to connect the transfer station or facsimile machine to a LAN. This LAN interface may be used in addition to or as an alternative to the network communication capabilities of the communication interface 102.");

a second receiver to receive from the recipient device the designation of the conversion processes via a transmission medium different from that used by the first receiver (Fig. 3, element 102, COMM. I/F "PSTN" or LAN I/F element 126, Fig. 7b, col. 5, line 56-60, "There is a communication interface 102 which may be utilized to connect to a computer network or a PSTN. The communication interface 102 may be implemented to have the structure and function of a fax interface and/or a LAN or other network interface.", col.6, line 26-3, "Connected to the system bus is a LAN interface 126 which may be utilized to connect the transfer station or facsimile machine to a LAN. This LAN interface may be used in addition to or as an alternative to the network communication capabilities of the communication interface 102.");

a switcher to switch between the first and second receivers depending on a recipient using the recipient device (Fig. 3, element 100, col. 5, line 50-55, " FIG. 3 illustrates, in block diagram format, the structure of a fax machine and/or transfer station utilized in the system of FIGS. 2A and/or 2B. A CPU 100 may be implemented using any desired microprocessor, microcontroller, or other circuitry which can control the functions of the fax machine and/or transfer station.");

a converter to perform the conversion processes on the image data stored in the storage device based on the conversion processes; and a transmitter to transmit the image data that has undergone the conversion processes to the recipient device (col. 2, line 32-36, "For example, if the receiving facsimile machine is capable of receiving facsimiles in a "fine" or "detail" mode, or can use a half-tone method of communication, these higher quality images are utilized and transmitted, when desired.")

Referring to claim 2,

Mali teaches a data transmission apparatus according to claim 1, wherein the requester has a mail transmitter to transmit an e-mail to request the designation of the conversion processes (col. 2, line 22-32, "The transmitting facsimile machine may be connected to a PSTN in a conventional network, or alternatively, is capable of directly generating electronic mail messages, or other communications which are transmitted over the Internet or another network. After the transmitting facsimile machine queries, over a computer network such as the Internet, the capabilities of the receiving facsimile machine, the transmitting facsimile machine may transmit the facsimile using the maximum capabilities of the receiving facsimile machine.")

Referring to claim 3,

Mali teaches a data transmission apparatus according to claim 2, wherein the first receiver receives the designation of the conversion processes based on an instruction sent from the recipient device via a setting screen that is used to designate of the conversion processes and that was referred to by the recipient based on information that was attached to the e-mail and indicates location of data for the setting screen (**Fig. 3, LAN I/F element 126**); and wherein the second receiver receives the designation of the conversion processes via an e-mail that was returned from the recipient in response to the e-mail sent by the mail transmitter (**Fig. 3, element 102, COMM, I/F “network”, Fig. 7c**).

Referring to claim 4,

Mali teaches a data transmission apparatus according to claim 3, wherein the switcher switches to the first receiver when a domain name in an e-mail address of the recipient is identical to a domain name in an e-mail address of a sender (**Fig. 3, element 102, COMM, I/F “network”, Fig. 7c, col. 5, line 56-60**, “There is a communication interface 102 which may be utilized to connect to a computer network or a PSTN. The communication interface 102 may be implemented to have the structure and function of a fax interface and/or a LAN or other network interface.”, col.6, line 26-3, “Connected to the system bus is a LAN interface 126 which may be utilized to connect the transfer station or facsimile machine to a LAN. This LAN interface may be used in addition to or as an alternative to the network communication capabilities of the communication interface 102.”), and to the second receiver when the domain name in

the e-mail address of the recipient is different from the domain name in the e-mail address of the sender (**Fig. 3, LAN I/F element 126, col. 5, line 56-60**, "There is a communication interface 102 which may be utilized to connect to a computer network or a PSTN. The communication interface 102 may be implemented to have the structure and function of a fax interface and/or a LAN or other network interface.", col.6, line 26-3, "Connected to the system bus is a LAN interface 126 which may be utilized to connect the transfer station or facsimile machine to a LAN. This LAN interface may be used in addition to or as an alternative to the network communication capabilities of the communication interface 102.").

Referring to claim 5,

Mali teaches a data transmission apparatus according to claim 1, wherein the conversion processes include at least a resolution conversion process, a color conversion process or a file format conversion process (col. 2, line 32-36, "For example, if the receiving facsimile machine is capable of receiving facsimiles in a "fine" or "detail" mode, or can use a half-tone method of communication, these higher quality images are utilized and transmitted, when desired.")

Referring to claim 6,

Mali teaches a data transmission apparatus according to claim 1, further comprising a recipient change receiver to receive an instruction to change the recipient, and wherein the transmitter transmits the image data that has undergone the conversion processes to a new recipient when the recipient is changed (**col. 5, line 56-60**, "There is a communication interface 102 which may be utilized to connect to a

computer network or a PSTN. The communication interface 102 may be implemented to have the structure and function of a fax interface and/or a LAN or other network interface.", col.6, line 26-3, "Connected to the system bus is a LAN interface 126 which may be utilized to connect the transfer station or facsimile machine to a LAN. This LAN interface may be used in addition to or as an alternative to the network communication capabilities of the communication interface 102.")

Referring to claim 7,

Mali teaches a data transmission method for transmitting image data over a network, the data transmission method (Abstract and col. 2, line 32-36, "For example, if the receiving facsimile machine is capable of receiving facsimiles in a "fine" or "detail" mode, or can use a half-tone method of communication, these higher quality images are utilized and transmitted, when desired.") comprising:

obtaining image data by reading an original document (col. 6, line 39-41, "A scanner 138 is utilized to scan images of documents which are to be transmitted by facsimile.");

storing the image data obtained in a storage device (col. 6, line 3-17, "A storage interface 110 is connected to a non-volatile memory 112, a hard disk 114, and a CD which may be a CD ROM drive, a write once/read many drive, a read/write drive which allows re-writing of data on the same disk, a magneto optical disk, or any other type of disk. The non-volatile memory may be limited as a RAM having a battery back-up, a flash memory, EPROM, EEPROM, CMOS battery, hard disk, or any other non-volatile memory device. The non-volatile memory 112 may be utilized to store autodial or

speed dial telephone numbers. Additionally, or alternatively, the non-volatile memory 112 is utilized to store profile or capabilities data. This data may be from facsimile machines with which the device of FIG. 3 communicates, or may be utilized to store the options and capabilities of the device illustrated in FIG. 3.");

requesting, via a transmission to a recipient device to which the image data stored in the storage device is to be sent, that the a recipient using the recipient device designate designates conversion processes to be performed to the image data (Fig. 8, col. 12, line 58- col. 13, line 2, "FIG. 8 illustrates a data structure 340 which includes the profile information of a fax machine which sets forth the capabilities of the fax machine. The data structure 340 includes a field 342 which indicates whether the fax machine can transmit in standard, detail, and/or fine mode. Field 344 indicates whether the fax machine has half tone capabilities, and field 346 indicates the various paper sizes which can be utilized by the fax machine. Field 348 illustrates the maximum transmission speed of the fax machine and can be, for example, 2.4 K, 4.8 K, 9.6 K, 14.0 K, 19.2 K, 32.0 K, 48.0 K, 56.0 K, 64.0 K, 128.0 K, or another transmission speed. Any other speed information may be stored, if desired.");

receiving from the recipient device, a designation of the conversion processes via one of multiple different transmission media specified depending on the recipient device (Fig. 8);

performing the conversion processes to the image data stored in the storage device based on the designation of the conversion processes and sending to the

recipient device the image data that has undergone the conversion processes (Fig. 8, col. 13, line 3-27).

Referring to claim 8,

Claim 8 is a claim to a data transmission program that causes a computer to execute a process in accordance with the method of claim 8. Therefore claim 8 is rejected for the reasons set forth for claim 7.

Referring to claim 9,

Mali teaches a data transmission program according to claim 8, wherein requesting of the designation of the conversion processes is made through transmission of an e-mail (col. 2, line 22-32, "The transmitting facsimile machine may be connected to a PSTN in a conventional network, or alternatively, is capable of directly generating electronic mail messages, or other communications which are transmitted over the Internet or another network. After the transmitting facsimile machine queries, over a computer network such as the Internet, the capabilities of the receiving facsimile machine, the transmitting facsimile machine may transmit the facsimile using the maximum capabilities of the receiving facsimile machine.")

Referring to claim 10,

Claim 10 is a claim to a data transmission program that causes a computer to execute a process in accordance with the method of claim 3. Therefore claim 10 is rejected for the reasons set forth for claim 3.

Referring to claim 11,

Claim 11 is a claim to a data transmission program that causes a computer to execute a process in accordance with the method of claim 4. Therefore claim 11 is rejected for the reasons set forth for claim 4.

Referring to claim 12,

Claim 12 is a claim to a data transmission program that causes a computer to execute a process in accordance with the method of claim 6. Therefore claim 12 is rejected for the reasons set forth for claim 6.

Referring to claim 13,

Claim 13 is a claim to a recording medium readable by a computer in which the data transmission program recited in claim 8 is stored. Therefore claim 13 is rejected for the reasons set forth for claim 8.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHOK B. PATEL whose telephone number is (571)272-3972. The examiner can normally be reached on 6:30 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan A. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ashok B. Patel/

Primary Examiner, Art Unit 2154